



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/765,901	01/07/97	PRAT	E 004900-148

IMS1/1218
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EXAMINER	
HENDRICKSON, S	
ART UNIT	PAPER NUMBER
1754	12

DATE MAILED: 12/18/98

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 12/18/98 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: _____

Claims objected to: _____

Claims rejected: 22-46

However:

☒ Applicant's response has overcome the following rejection(s): Rejection 1) under 35 USC 112 2nd paragraph

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection, because See attachment

5. ☐ The affidavit or exhibit _____ presented.

used drawing correction ☐ has ☐ has not been approved by the examiner.

Art Unit: 1754

The argument concerning "if appropriate" is not persuasive. If all was initially added, then there is none to add later. If only part was added initially, then it appears (according to the arguments) that the rest is REQUIRED to be added. In either event, there is no decision possible. In that "if appropriate" implies a choice to be made, the phrase is not appropriate in the claim since there is no choice to be made. It is not clear how one makes the choice that the claim implies is present and specification pgs. 7-9 offer no guidance or definition of what is appropriate.

Concerning the wet cake, it does not appear correct that mere crumbling of a solid material will create a solution. It appears that further addition of water is necessary. Water of hydration is generally not present in sufficient quantity so as to dissolve a material. Why would the water wait so long before it dissolves the solid? A Declaration is suggested and more data is needed. It is not clear what is compared or how it is compared, or what is being shown. The claims are not limited to the results alleged.

Chevallier teaches 24% solids content. The claims do not require the 7500 rpm centrifuging treatment.

SLM


Michael Lewis
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